



United States Patent and Trademark Office

MAILED FROM
DIRECTORS OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

AUG 22 2006

TECHNOLOGY CENTER 2800

Paper No. None

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

In re Application of	:	
Takanori SHIMIZU, et al.	:	
Application No. 10/511,630	:	
Filed: October 19, 2004	:	
Attorney Docket Number: NE297-	:	DECISION ON PETITION
PCT(US)	:	UNDER 37 C.F.R. §1.181
Title: OPTOELECTRONIC HYBRID	:	
INTEGRATED MODULE AND	:	
LIGHT INPUT/OUTPUT	:	
APPARATUS HAVING THE SAME	:	
AS COMPONENT	:	

This is a decision on the petition filed March 16, 2006, to enter the Amendment Under 37 C.F.R. §1.111 filed on November 30, 2005. Granting this petition would necessitate reversing the examiner's holding in the "Notice of Non-Responsive Amendment" mailed on February 28, 2006 that such amendment was not fully responsive to the prior Office action mailed August 31, 2005.

Petitioner states that the examiner relies upon MPEP §§818.01 and 818.02(a) for support and concludes that since the examiner never issued a restriction requirement, no designation of an elected invention was ever made. However, in conjunction with MPEP §§818.01 and 818.02(a), the examiner's "Notice of Non-Responsive Amendment" mailed on February 28, 2006 also relied upon MPEP §§821.03 entitled "Claims for a Different Invention Added After an Office Action" for the action taken in the "Notice of Non-Responsive Amendment" mailed on February 28, 2006.

MPEP §§821.03 is reproduced in full as follows:

821.03 [R-3] Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP § 818.01, §818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § § 1.143 and 1.144

The action should include form paragraph 8.04.

¶ 8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §821.03.

****>A< complete action on all claims to the elected invention should be given.****

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

¶ 8.26 Canceled Elected Claims, Non-Responsive

The amendment filed on [1] canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because [2].

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

>The practice set forth in this section is not applicable where a provisional election of a single species was made in accordance with MPEP § 803.02 and applicant amends the claims such that the elected species is cancelled, or where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.<

The examiner's "Notice of Non-Responsive Amendment" mailed on February 28, 2006 did not explicitly make reference to MPEP §§821.03 and furthermore did not use the language set forth therein which makes clear that when

"... applicant has received an action on the merits for [the] an originally **presented** (emphasis added) invention, this invention has been constructively elected by original presentation for prosecution on the merits." (Form paragraph 8.04)

The preceding sets forth clearly that the absence of a designation of an elected invention as a result of a restriction requirement does not prevent a constructive election by original presentation for prosecution on the merits.

Petitioner asserts that originally filed claims 1 and 3-12 were generic to the invention in all of Figures 1-8 and that there was no implied election of Figures 7 and 8 as alleged by the examiner.

To support the holding of non-responsiveness, the examiner argued the following points:

- 1) Original claims 1 and 12 did not limit the location of the mounting of the flip-chip to "a surface of" the transparent base material and thus may have intervening layers.
- 2) Original dependent claims 7-9 further limit claim 1 by stating that the transparent base material is overlaid with "light coupling means" and is thus limited to the structure shown in Figure 7 and 8.
- 3) Amended claims 1 and 12 recite a flip-chip mounting directly to the transparent base material surface, which is limited to the structure of Figures 1-6, which invention was non-elected by action on the merits.

Referring to point one, the examiner incorrectly implies that mounting the flip-chip to "a surface of" the transparent base material excludes intervening layers; such exclusion is not supported by originally filed claim 1. Thus petitioner is correct in asserting that original claim 1 is generic to the invention in all of Figures 1-8.

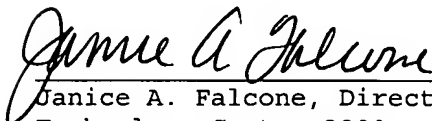
Referring to point two, the examiner is correct with regards to claims 7-9, but again incorrectly implies that claim 1 would be limited accordingly.

Referring to point three, the examiner again incorrectly states that amended claims 1 and 12 are now limited to the structure of Figures 1-6; such exclusion is not supported by the claim since (for example) amended claim 1 does not either implicitly nor explicitly state that the surface in question is the entire surface of the transparent material or of the optical device, so as to exclude any other possible intervening layer.

Conclusion

For the reasons discussed above, the petition under 37 C.F.R. §1.181 must be GRANTED.

The examiner is hereby directed to enter the Amendment Under 37 C.F.R. §1.111 filed on November 30, 2005 and to subsequently issue an Office action in response thereto.



Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components